

data storage means for storing data related to the timing of reports required by each of a plurality of users;

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data server means for providing a reporting form to users who log onto the web site and for receiving reports from users; and

Cont'd
data processing means for identifying, from the stored data and received reports, users who have failed to make a timely report,

wherein the user makes multiple reports and

wherein the data processing means stores the multiple reports made by each user and compares a user's current report with a previous report of that user.

REMARKS

The thorough examination of the present application is acknowledged with appreciation.

Amendments and Formal Rejections Under 35 U.S.C. §112

Dependent claim 13 has been amended to clarify the selection of hyperlinks by the electronic system. Dependent claim 15 has been amended to provide antecedent basis for the recited "previous report" and "current report." The amendments are believed to clarify rather than narrow and are believed to obviate the Examiner's formal rejections.

Independent claim 1 has been amended to incorporate the language of previous dependent claim 4, now canceled. Independent claim 20 has been amended to incorporate the language of previous dependent claim 29, now canceled. No narrowing of the dependent claims, as published, is intended.

Art Rejections

The Disclosed System

Broadly, the present application discloses a system for monitoring visitors from abroad that uses interaction between the user (the foreign visitor) and the Internet to encourage compliance with the immigration laws and deter terrorist or criminal activity. Terrorist or criminal activity is deterred when the potential actor perceives that the risk of failure in the commission of the offense, or that the likelihood of capture due to commission of the crime is at an unacceptable level. Interaction between the user (the foreign visitor) and the system via the Internet increases the perception that any attempt to circumvent immigration regulations will be defeated and the potential bad actor will be brought to justice.

The system and method includes entering and storing personal identifying information for each visitor as listed on their respective authorized visa documents. Reports are required by law at intervals following entry. The visitors make internet reports from remote terminals such as PCs which are readily available throughout the country. A centralized system checks personal identifying information to verify the identity of reporting visitors. The system determines from stored timing information such as entry dates, personal information and received reports the identities of individuals who have failed to make timely reports. Notification of failure to make a timely report may be given to both the visitor and the visitor's sponsor, employer and/or school.

The Cited Art Is Remote from the Claimed Invention as a Whole

The Examiner has cited as primary references a system for scheduling the review of folders in an electronic mail system ("IBM") and a system for bill delivery and payment over a communications network (Hogan '528). The particulars of the rejections are discussed below. However, the art rejections suffer from a basic defect -- the rejections ignore the claimed context, actors, specific actions and results. No prior art is cited which addresses the problems addressed by the claimed subject matter. Bill collections and office management involve wholly different activities, purposes and contexts, than enforcing the immigration laws and deterring terrorist or criminal activity by non-immigrant visa holders.

It is improper to dismiss claim limitations as not having patentable weight. This is implicitly done in interpreting the present claims as if they were directed to a generalized piece of business software. Every limitation in a claim must be given effect rather than considering one in isolation from the others. In re Geerdes, 491 F.2d 1260, 1262-63, 180 U.S.P.Q. 789, 791 (CCPA 1974). The determination of patentability turns on whether the subject matter of the claim as a "whole" is patentable. 35 U.S.C. § 103(a).

In the present invention, the type of information processed is important to the invention. Here, the information concerns timing and identity particularly related to immigration overstay. The nature of the information processed cannot be excised from the claim in evaluating patentability. *See, e.g., In re Gulack*, 703 F.2d 1381, 217 U.S.P.Q. 401 (Fed. Cir. 1983). This approach is consistent with the Federal Circuit's more recent decision in State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d 1368, 47 U.S.P.Q. 2d 1596 (Fed. Cir. 1998). In that case the claim was to a data

processing system for managing a financial service. The court did not interpret the claim in suit simply as a generalized data processing system. Rather, the Court stated that the claim "properly construed, claims a machine, namely a data processing system for managing a financial services configuration of a portfolio established as a partnership" 149 F.3d at 1372, 47 U.S.P.Q. 2d at 1599-1600. Similarly the claimed invention is not merely a method of applying data processing to multiple participants and deadlines. Rather it is as, for example, stated in claim 1 "[a] method of countering international terrorism requiring Non-Immigrant Visa Holders (users) to report during their respective visits at one or more times and monitoring such reporting using the internet and an electronic system and database . . .".

Moreover, art rejections can only be premised on "analogous" prior art. In re Clay, 966 F.2d 656, 23 U.S.P.Q. 2d 1058 (Fed. Cir. 1996). There has been no demonstration that bill collection or office folder management are in the same field as countering terrorism or monitoring visitors from abroad. Nor has there been a showing that one skilled in the immigration field would look to office folder management or bill collection, to solve the problem of potentially uncooperative or dangerous individuals who enter the country and, effectively, "disappear"; individuals who may attempt to conceal their identity; or individuals interspersed with large numbers of non-threatening visitors presenting major problems of location, identification, data entry, data collection and data evaluation.

IBM and Hogan

Claims 1-9, 12-14, 20, 21, 23, 25, 27, 28, 30 and 31 stand rejected under 35 U.S.C. §§ 102 or 103 as anticipated or obvious over IBM Technical Disclosure Bulletin

("IBM"). IBM deals with scheduling of review of folders by individuals in an organization. The Examiner has implicitly equated IBM's storing of information about a folder (i.e., when it was supposed to be reviewed) with storing of information about the identity, comings and goings of a human being, the Non-Immigrant Visa Holder.

Claims 1, 10, 11, 16-19, 24 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hogan in view of IBM. The Hogan patent (U.S. Patent No. 5,699,528) discloses a system and method for bill delivery and payment over a communications network.

The Examiner has admitted that IBM does not disclose a web site. Claim 1 has been amended to make clear that the internet is employed in the method and that the reporting user logs onto the website associated with the electronic system and transmits the information requested by the website¹. Thus, the data entry responsibilities are placed on the numerous visitors from abroad who must make periodic reports, rather than on an otherwise over-burdened bureaucracy. The claim makes it clear that it is individuals, (not folders) which are monitored, that reporting occur at a time based on visa documentation, that the reporting is from remote terminals and that the primary goal is not reviewing folders on schedule as in IBM, but identifying visa holders who have failed to make a timely report.

The Examiner has admitted that Hogan does not specifically teach the step of determining from the records the identity of subscribers who have failed to make timely

¹ Claim 1 combines the recitation of original claim 1 and those of dependent claim 4.

reports and transmitting notices identifying those who have failed to do so. Hogan deals with a different category of users -- bill payers. As noted above, the time intervals dealt with in IBM are associated with folders. There is no teaching or motivation to combine the two systems to create a system for monitoring the presence of a totally difference class of users -- non-immigrant visa holders. Accordingly, the rejections of claim 1 and claims dependent thereon are believed to be in error.

Dependent claims 3 and 23 recite the further step or means of transmitting notification to at least one of user's sponsor, employer, or school that the non-immigrant visa holder has failed to make a timely report. The notifications used in the present system are designed to influence the non-immigrant visa holders' behavior. Delivering the message of non-compliance to these other persons or entities is a personal and powerful mechanism of influencing behavior. The governmental power to contact, gather and use, in a coercive way, information about a person's personal life and associates is almost unique to the immigration and criminal justice system. It is not a feature of normal office management (IBM) or bill collection (Hogan).

Amended dependent claim 15 and amended independent claim 20 include provision for making comparisons of a user's current and previous reports². This checking of previously entered data is for determining the on-going truthfulness of a particular user. A user who is accurately describing their home address, parents, siblings, schools attended, etc. would not change this information over time for a simple reason that their personal

² Amended claim 20 combines the recitations of original independent claim 20 with those of original dependent claim 29.

history is their personal history. One who is attempting to mislead the system would be found out by the action of comparing the history input during one session with the history input during another session. In contrast, IBM assumes the honesty of the folder reviewers and is seeking information not already known. Similarly, Hogan is interested in determining the state of a bill, not determining whether the bill payer is lying about his identify.

Independent claim 16 is a method of monitoring visitors from abroad. It involves entering personal identifying information for each visitor as listed on their respective authorized visa documentation. Of course, IBM and Hogan say nothing about visa information and information related to the timing of a required report. Claim 16 establishes a central data base for each visitor including identifying information. A web site is accessed from remote terminals (such as a PC) from which reports are received from the visitors including the personal identifying information. The system determines the identity of visitors who have failed to make timely reports and transmits notices of that failure. Here the system is concerned with particular individuals (visitors from abroad), visa identification information, personal identity and the making of timely reports during the visitor's stay. IBM and Hogan deal with completely different contexts, problems and goals, as discussed above.

The Unapplied Art

The Examiner has also cited the Watson bill consolidation system and ITT Education Services loan accreditation system. Like IBM and Hogan they deal with completely different contexts, actors, activities, problems and goals. Layson, Jr. and

Ladue teach portable tracking methods to determine the physical location of criminal offender (i.e., latitude and longitude, or in the house/not in the house). In contrast, the present system uses the responses of non-immigrant visa holders to effect compliance with immigration laws and verify identity. The similarity of the systems lies only in the broad purpose of enforcing laws.

Brown teaches the collection of information via the web of information regarding the health regime of a user to aid that user in maintaining good health via notification of user's compliance with the regime. Once again the cited art deals with completely different contexts, actors, activities, problems and goals.

Finally, it is noted that in Applicant's parent application the Examiner has cited U.S. Patent No. 6,039,688 to Douglas et al. The Douglas et al. patent relates to a therapeutic behavior modification program, compliance monitoring and feedback system. In detail the the claimed methods and systems differ from the Douglas program in numerous ways: Non-Immigrant Visa holders and visitors are not patients; admission to the country is not a discretionary enrollment in a program by a physician; the timing of the admission and immigration reporting requirements are not the same or analogous to a medical history; the automated identification of individuals who failed to make timely reports is not the same as a subjective evaluation of whether a health risk is present; automatic notification to a responsible governmental enforcement body and to another body or individual such as an employer is not the same as the alarm notification of a doctor of a health risk; etc. This reference is believed to be no more than cumulative with the references already cited in the present action and discussed above.

For the foregoing reasons, the claims are believed to patentably define over the art of record and should be allowed. If any minor matters remain after consideration of this amendment, the Examiner is requested to contact the undersigned by telephone to insure early issuance of a patent to Applicant.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 

Samuel C. Miller III
Registration No. 27,360

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

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Attachment to Amendment dated December 10, 2002

Marked-up Claims - 1, 13, 15 and 20

1. (Amended) A method for countering international terrorism requiring Non-Immigrant Visa Holders (users) to report during their respective visits at one or more times and monitoring such reporting using the internet and an electronic system and database, comprising the steps of:

storing information from users' authorized visa documentation in the data base including information related to the timing of required reports by the users;

receiving over the internet reports from users made from remote terminals by users wherein the reporting users

log onto a website associated with the electronic system and database
and;

transmit over the internet to the electronic system and database
information requested by the website; and

determining from said stored timing information and received reports, the identity of individuals who have failed to make timely reports.

13. (Amended) The method of claim 12, further comprising the step of the electronic system selecting hyperlinks on the basis of stored information about the [user] Non-Immigrant Visa Holder making the report.

Attachment to Amendment dated December 10, 2002

Marked-up Claims - 1, 13, 15 and 20

15. (Amended) The method of claim 1, wherein reporting Non-Immigrant Visa Holders make multiple reports, including a current and a previous report, and further comprising the step of comparing each reporting user's current report with at least one previous report.

20. (Amended) Data processing system for monitoring [users] Non-Immigrant Visa Holders (users) who are required to make reports over the internet from remote terminals to a web site associated with the data processing system comprising:

data storage means for storing data related to the timing of reports required by each of a plurality of users;

data server means for providing a reporting form to users who log onto the web site and for receiving reports from users; and

data processing means for identifying, from the stored data and received reports, users who have failed to make a timely report,

wherein the user makes multiple reports and

wherein the data processing means stores the multiple reports made by each user and compares a user's current report with a previous report of that user.